

REMARKS

Claims 1-15 were originally presented. New claims 16-19 were presented in the response filed December 17, 2007. Claims 1-8, and 18 were revised and new claims 20-21 were submitted in the response filed August 15, 2008. Claims 6, 8, 16, 18 and 19 were amended in the supplemental amendment to Request for Continued Exam, filed on November 5, 2008. Claims 1 and 2 were amended in the response filed February 25, 2010. The claims presently under consideration are thus claims 1-21, as set forth herein. These claims are supported by the specification as filed, and Applicant believes that no new matter has been added. Applicant respectfully requests that the Examiner reconsider and withdraw the various grounds of rejection of the claims.

Detailed Action

The Examiner states that the response filed on February 25, 2010 was not fully responsive to the prior Office Action because the response did not specifically address the obviousness rejection of claims 6 and 16 on page 10 of the September 25, 2009 office action.

In response Applicant provides the further comments set forth below.

35 USC 103

On page 10 of the September 25, 2009 office action the Examiner rejects claims 6 and 16 under 35 U.S.C. 103(a) as being unpatentable over Resnick (US 2002/0141760) (hereinafter "Resnick"); Ding (PSTT, Vol. 1, No. 8, Nov 1998) (hereinafter "Ding"); Vandamme (Progress in Retinal and Eye Research 21 (2002) 15-34) (hereinafter "Vandamme"); Nagarsenker et al (Int. Journal of Pharmaceutics 190 (1999) 63-71) (hereinafter "Nagarsenker"); Paul et al (Current Science, Vol. 80, No8, 25 April 2001) (hereinafter "Paul"), and in further view of Raut (US 2003/02216431).

Applicant continues to note that the Examiner requires no less than six (6) separate references to reject the claims 6 and 16. The Examiner is requiring the skilled artisan to piece disparate elements of the present invention from each of the multiple cited references. Applicant refers the Examiner to *Ex parte Gambogi*, 62 USPQ2d 1209; *In re Herrick*, 145 USPQ 400; *In re Gorman*, 18 USPQ2d 1885; *In re Yates*, 211 USPQ 1149; *In re Rijckaert*, 28 USPQ2d 1955; *Corometrics v. Berkeley*, 193 USPQ 467; and *Gen. Tire v. Firestone*, 174 USPQ 427 (The fact that such a unique,

multi-tiered combination of six references is required herein complicates the Examiner's burden of reasonably connecting so many disparate teachings in a logical and coherent manner in order to establish a *prima facie* case of obviousness).

As to the references Resnick, Ding, Vandamme, Nagarsenker, and Paul, Applicant refers the Examiner to the remarks provided in the February 25, 2010 response. Related to Raut, Applicant further notes that Raut published on **November 20, 2003**. The present application is a Continuation in Part of 10/454,836 filed 6/5/2003 (now issued patent 7,638,137), and claims priority to provisional application 60/385,571 filed **June 5, 2002**. Applicant therefore submits that given Applicant's priority date **prior** to Raut's publication date – Raut is not a proper prior art reference to the present application.

To be considered as a reference under 35 USC 103(a) the reference must be prior art within 35 USC 102. Applicant provides 35 USC 102 (a), (b), and (e) below:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, **before the invention thereof** by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, **more than one year prior to the date of the application for patent in the United States**, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant** for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(emphasis added)

Applicant notes that given that the priority date of Applicant's invention is prior to the publication of Raut, a declaration under 37 C.F.R.

§ 1.131 should not be needed. If the Examiner believes otherwise, the Applicant requests further clarification.

Applicant has earnestly endeavored to place the application in condition for allowance and favorable action toward that end is respectfully requested. The Commissioner is hereby authorized to charge to Deposit Account No. 50-1165 (T2315-908542US02) any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

Respectfully submitted,

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